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Kazuma Sato

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EXAMINER

NGUYEN, TAN D

ART UNIT

PAPER NUMBER

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/840,892	<b>Applicant(s)</b> SATO ET AL.	
	<b>Examiner</b> Tan Dean D. Nguyen	<b>Art Unit</b> 3689	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 10 October 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 94, 100, 104, 108 and 109 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 94, 100, 104, 108 and 109 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>10/10/06 and 11/13/07</u> .                                   | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### *Response to Amendment*

1. The amendment of 10/10/2006 has been entered. Claims 94, 108-109, 100, 104, are pending and rejected as below.

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

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consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

**5. Claims 100 (method), 94 (apparatus), 108-109, and 104 (computer program product) are rejected under 35 U.S.C. 103(a) as being unpatentable over (1) Applicant Admitted Prior Art (AAPA) in view of (2) ASAMI et al (US 2001/0005833).**

Claim 100 is as followed:

100. (currently amended): A method of controlling a server, which communicates with a plurality of client computers through a computer network, for discriminating log-in information received from each client computer, and transmitting data of an order screen used by a user for the purpose of ordering a new consumable, to a logged-in client computer, said method comprising the steps of:

(a) inputting order data inputted by a user who uses the order screen displayed on a monitor of the logged-in client computer;

(b) inputting collecting data of a used consumable returned from a user;

c) storing the order data and the collecting data in relation with the log-in information to a database;

d) calculating the user's incentive data based on a plurality of the order data and a plurality of the collecting data stored in the database in a unit of the log-in information;

(d) generating price data of the new consumable in accordance with the user's incentive data in the unit of the log-in information;

(e) providing the logged-in client computer with the price data corresponding to the log-in information of that to display a price of the new consumable on the order screen; and

(f) providing, in response to an instruction of the user, the logged-in client computer with data of a confirmation screen, which includes the order data, the collecting data, and the incentive data corresponding to the log-in information of that client computer, to report a collection rate of the used consumable, and the incentive data as a discount rate of a new consumable to the user.

Note: for convenience, letters (a)-(f) are added to the beginning of each step.

Note in step (b), the phrase "...of a used ...from a user" is not a positively recited method step but, rather, is mere intended use of the collected data and thus having no patentable weight. See MPEP 2173.05 (q), 2106, and 2111.04, which indicate that a method claim requires active, positive steps. Furthermore, it is considered as non-functional descriptive material (NFDM) on the data of "...", thus having no patentable weight. The limitation does not "impart functionality when employed as a computer component", thus having no patentable weight.

See MPEP 2106.01 "Descriptive material can be characterized as either "functional descriptive material" or "nonfunctional descriptive material." In this context, "functional descriptive material" consists of data structures and computer programs

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which impart functionality when employed as a computer component. (The definition of “data structure” is “a physical or logical relationship among data elements, designed to support specific data manipulation functions.” The New IEEE Standard Dictionary of Electrical and Electronics Terms 308 (5th ed. 1993).) “Nonfunctional descriptive material” includes but is not limited to music, literary works, and a compilation or mere arrangement of data.

Similarly, in step (f), the phrase “to report ... to the user” is not a positively recited method step but, rather, is mere intended use of the providing data and thus having no patentable weight. See MPEP 2173.05 (q), 2106, and 2111.04, which indicate that a method claim requires active, positive steps. Furthermore, it is considered as non-functional descriptive material (NFDM) on the data of “...”, thus having no patentable weight. The limitation does not “impart functionality when employed as a computer component”, thus having no patentable weight.

**As for independent method claim 100, AAPA**, as shown under the “Background of the Invention”, specification pages 1-3, Figs. 1-2, discloses a collecting method of collecting used items, i.e. office supplies, comprising the steps:

b) collecting client’s collecting data (collecting rate) of the items, used consumable, i.e. office supplies, returned from a user, by a collecting center or the like (dealer);

d) calculating the client’s collecting rate and incentive data compliance with the collecting data above wherein the calculating is carried out by collates collecting data of the customer with a record of orders accepted (sale);

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f) providing information about the collecting rate and incentive data on a report to the client by conventional method, which is by mail. AAPA fairly teaches the claimed invention except for:

A method of controlling a server, which communicates with a plurality of client computers through a computer network, for discriminating log-in information received from each client computer, and transmitting data of an order screen used by a user for the purpose of ordering a new consumable, to a logged-in client computer, comprising the steps of:

(a) inputting data by a user who uses the order screen displayed on a monitor of the logged-in client computer, wherein the data is ordering data;

(b) inputting data, wherein the data is of a used consumable returned from a user;

(c.) storing the order data and the collecting data in relation with the log-in information to a database;

(e) generating price data of the new consumable in accordance with the user's incentive data in the unit of the log-in information;

(f) carrying out step (f) above on the order screen; and

(g) providing, in response to an instruction of the user, the logged-in client computer with data of a confirmation screen , which includes the order data, the collecting data, and the incentive data corresponding to the log-in information of that client computer, to report a collection rate of the used consumable, and the incentive data as a discount rate of a new consumable to the user.

In a similar system for managing purchase order and incentives on the Internet, **ASAMI et al** discloses a method of controlling a server, which communicates with a plurality of client computers through a computer network, for discriminating log-in information received from each client computer, and transmitting data of an order screen used by a user for the purpose of ordering a new consumable, to a logged-in client computer, comprising the steps of:

(a) inputting data by a user who uses the order screen displayed on a monitor of the logged-in client computer, wherein the data is ordering data;

(b) inputting data, wherein the data is of a used consumable returned from a user {see [0073 “reselling PC-related products which he owns to a PC used goods shop which has a store terminal 2” ... “a member can also receive award points in place of payment for trade-in of products ... “pool points” .. can be used in place of cash during subsequent product purchases”];

(c.) storing the order data and the collecting data in relation with the log-in information to a database;

(e) generating price data of the new consumable in accordance with the user's incentive data in the unit of the log-in information {see [0033, 0073]};

(f) carrying out step (f) above on the order screen; and

(g) providing, in response to an instruction of the user, the logged-in client computer with data of a confirmation screen , which includes the order data, the collecting data, and the incentive data corresponding to the log-in information of that client computer, to report a collection rate of the used consumable, and the incentive

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data as a discount rate of a new consumable to the user {see [0084, 0128 "confirmation page 120", Fig. 9, 120 "*CONFIRMATION PAGE*", "*1. PRODUCT ORDERED*", "*CUSTOMER REGISTRATION DETAILS*", "*PAYMENT METHOD*", Fig. 18 "*PRICE DIFFERENCE*", Fig. 19 "*AWARD POINTS*", "*TRADE-IN AMOUNT*",], etc. Therefore, the reporting of any other information on the screen for confirmation would have been obvious to a skilled artisan as mere selection of other desired information for confirming purpose. Note that well known benefits of the Internet system to a skilled artisan are low cost, availability, quickly and instantly access on a real time basis and automatically updating ability {see Figs. 2, 12, 19, [0022]} as well as permitting viewing of incentives (award points) on a website in the context of a product sale system and to a capability for use and addition of such incentives or points {see [0001]}.

Therefore, it would have been obvious to a skilled artisan (businessperson or marketer) at the time the invention was made to modify the manual business practice of (Ref 1) AAPA by converting the practice to automatic practice using computer devices on Internet system with multiple databases for monitoring customer's purchasing history and providing instant bonuses, rewards to increase potential sales and business revenues due to using the Internet and its benefits as taught by ASAMI et al above.

6. **As for independent system claim 94**, which is the respective system containing the respective elements to carry out the respective steps (a), (b), (c.), (d), (e), (f) and (g) of independent method claim 100 above, it's rejected over the respective system to carry out the respective steps as taught by AAPA / ASAMI et al above.

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As for dep. claims 108-109 (part of 94 above), which deals with well known incentive/award points determining parameters, i.e. as a function of collecting state and order state, these are fairly taught in AAPA page 3, lines 1-3 or ASAMI et al [0003-0008 “award points .... To the value of transactions conducted to date”]

7. **As for computer program product claim 104**, which is the respective computer program product to carry out the respective steps (a), (b), (c.), (d), (e), (f) and (g) of independent method claim 100 above, it's rejected over the respective computer program product to carry out the respective steps as taught by AAPA / ASAMI et al above.

8. **Claims 100 (method), 94, 108-109 (system), and 104 (program product) are rejected under 35 U.S.C. 103(a) as being unpatentable over (1) Applicant Admitted Prior Art (AAPA) in view of (2) WALKER et al (US Patent 6,567,787) and (3) SPARKS et al .**

**As for independent method claim 100, AAPA**, as shown under the “Background of the Invention”, specification pages 1-3, discloses a collecting method of collecting used items, i.e. office supplies, comprising the steps:

a) collecting client's collecting data (collecting rate) of the items, used office supplies, which is accumulated in a memory for respective clients;

b) calculating information on incentive in compliance with the collecting data above; and

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c) providing information (report) to the client by conventional method, which is by mail, wherein the information includes the information on the incentive” {see page 3, line 5}. AAPA fairly teaches the claimed invention except for 2 limitations:

(1) including an “updating” function in the “collection” function of step a), and  
(2) carrying out the providing function of step c) on a displaying device (screen),  
by which the client orders the items, used office supplies.

In another similar method and apparatus for improving sales of items at point of contact with customer/client, i.e. point-of- sale (POS) terminal, **WALKER et al**, fairly teaches a step of:

a) collecting client’s data (or business transaction such as frequent shopping rating/status of “platinum” based on previous transactions such as (1) amount of money spent, (2) numbers of visits, payments for particular ratings, etc.), in a database {see col. 7, lines 30-44, col. 15, lines 60-67};

b) calculate (determine) information on incentive (discounts, promotional offers) for which the client is eligible based on the collected data updated {see col. 7, lines 5-45, especially line 44 “*determine... discounts or promotional offers .. customer is eligible*”}, and

c) provide the information, promotional offer or incentive, for which the customer is eligible, to the client/customer, thus increasing the chances of the customer’s acceptances of such offers, resulting in increase sales and profits {see col. 1, lines 40-55, col. 8, line 65- col. 9, line 10}. As for the further limitation of “updating” function in the “collecting” function of (a), this further limitation is fairly taught on col. 14, lines 41-

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45, wherein the well known and obvious feature of monitoring data/record, “*updating periodically*” the data for inherent/obvious purpose of obtaining the latest/current record about the client/customer, is mentioned. Therefore, it would have been obvious to apply this same further function on the collecting client’s data of a) above to collect the latest client’s data for accurate evaluation of current status.

Therefore, it would have been obvious to a skilled artisan (businessperson or marketer) at the time the invention was made to modify the manual business practice of (Ref 1) AAPA by converting the practice to automatic practice using computer devices with multiple databases for monitoring customer’s purchasing history and providing instant bonuses, rewards to increase potential sales and business revenues at point of sales (POS) {see col. 3, lines 10-22} as taught by (Ref 2) WALKER et al as indicated above. The teachings of AAPA /WALKER et al fairly teaches the claimed invention except for carrying out step (c) or “providing the information” on a screen by which the client order the items. Note that WALKER et al teaches that the information/data including the client’s incentive data is automatically and electronically transmitted to the POS terminal and is shown on a display device (computer screen or monitor) to the POS operator {see Fig. 2, (210)} wherein the operator informs (speaks) to the client about the information (message) including the promotional offers and waits for the client’s acceptances of the offers (orders) {see col. 7, lines 45-55, col. 8, line 65 to col. 9, line 10}.

Note that WALKER et al also mentions the possibility of the operator (cashier) failing to convey the promotional offers to the client/customer or giving an

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improper/wrong offers {see col. 1, lines 22, col. 7, lines 45-67}, it would have been obvious to modify the teachings of AAPA /WALKER et al by modifying the last step by allowing the client/customer to see the same information on the same screen or display device with the operator/cashier, thus avoiding the problems (possibility) of the operator (cashier) failing to convey the promotional offers to the client/customer or giving an improper/wrong offers as indicated above.

As for the difference in the business service of AAPA (collecting used office supplies and selling new office supplies) and WALKER et al (selling of any goods or services {see col. 3, lines 5-7}), the difference in the type of goods is not important and would have been obvious to a skilled artisan (marketer or businessperson) since the critical issue is making the historical business transaction information (frequent shopper database, Fig. 2) with all of details as shown on col. 7, lines 27-45, Fig. 2 and Fig. 7, available to the salesperson at point of contact with the client/customer so that a promotional offers, for which the customer is eligible, is made to the client/customer for more offering acceptances/sales {see col. 3, lines 15-20}. The inclusion of any other business practice or specific step for a specific application, i.e. collection rate of used office supplies, or exchanged items, etc., which is considered as business practice parameters, would have been obvious to a skilled artisan as mere routine experimentations of business practice parameters {see WALKER et al col. 16, lines 48-55}.

Alternatively, in a method and system for ordering items over the Internet, SPARKS et al discloses step (g) of providing, in response to an instruction of the user,

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the logged-in client computer with data of a confirmation screen, which includes all the essential ordered information for effective order confirmation and final order completion {see Figs. 59-62}. It would have been obvious to modify the teachings of AAPA / WALKER et al to include step (g) as taught by SPARKS et al for effective order confirmations.

9. **As for independent system claim 94**, which is the respective system containing the respective elements to carry out the respective steps (a)-(g) of claim 100 above, it's rejected over the respective system to carry out the respective steps as taught by AAPA / WALKER et al /SPARKS et al, especially in view of WALKER et al Fig. 2.

As for dep. claims 108-109 (part of 94 above), which deals with well known incentive/award points determining parameters, i.e. as a function of collecting state and order state, these are fairly taught in AAPA page 3, lines 1-3 or WALKER et al .

10. **As for computer program product claim 104**, which is the respective computer program product to carry out the respective steps (a)-(g) of claim 100 above, it's rejected over the respective program product to carry out the respective steps as taught by AAPA / WALKER et al /SPARKS et al, especially in view of WALKER et al Fig. 2.

***Response to Arguments***

11. Applicant's arguments filed 10/10/2006 have been fully considered but they are not persuasive.

12. 1) As for the priority date, this applications depends on 2 foreign priorities, one with a filing of 04/28/2000 and the other with a filing of 04/20/2001. The second date of 04/20/2001 is not prior to the filing date of ASAMI et al of 12/22/2000. Applicant has not indicated whether what portion of the claimed invention belonged to the early filing application or later application, and it's assumed the current application derived from both of the earlier applications. Therefore, ASAMI et al is still considered as a prior art.

13. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). ASAMI et al is cited to teach well known computer automation using the Internet in a business application with similar features such as resale of used product for discount or incentives. The various minor differences as being argued are within the skill of the artisan to make adjustment. Furthermore, as indicated above, these limitations do not patentable weight because they are merely intended use of the processed (order and collecting) data or non-functional descriptive materials as indicated above.

14. Similarly, the arguments with respect to the teachings of WALKER et al is not persuasive for the same reasons set forth above.

### Conclusion

15. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

1) US Patent 6,167,382 by SPARKS et al, discloses a method for ordering, purchasing of items using the Internet with displaying of "order confirmation" {see Fig. 61} and "Order Complete" {see Fig. 62} for multiple logged-in client computers {see Figs. 1-59}. The teaching of complete "order confirmation" and "order Complete" are cited here for applicant's awareness of potential use in the future if needed to show well known teachings of step (g) in claim 100 above.

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2) JP 6096094, 1994, discloses an article and device for collecting the article with merits/bonuses given to a user who cooperates with the collection system, similar to the teachings of AAPA cited above. It's cited for applicant's awareness for potential use in the future if needed to avoid citing duplicate rejections.

No claims are allowed.

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17. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through private PAIR only. For more information about the PAIR system, see <http://pair-direct@uspto.gov>. Should you have any questions on access to the private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free).

In receiving an Office Action, it becomes apparent that certain documents are missing, e. g. copies of references, Forms PTO 1449, PTO-892, etc., requests for copies should be directed to Tech Center 3600 Customer Service at (571) 272-3600, or e-mail [CustomerService3600@uspto.gov](mailto:CustomerService3600@uspto.gov).

Any inquiry concerning the merits of the examination of the application should be directed to Dean Tan Nguyen at telephone number (571) 272-6806. My work schedule is normally Monday through Friday from 6:30 am - 4:00 pm. I am scheduled to be off every other Friday.

Should I be unavailable during my normal working hours, my supervisor Janice Mooneyham can be reached at (571) 272-6805.

The main FAX phone numbers for formal communications concerning this application are (571) 273-8300. My personal Fax is (571) 273-6806. Informal communications may be made, following a telephone call to the examiner, by an informal FAX number to be given.

/Tan Dean D. Nguyen/  
Primary Examiner, Art Unit 3689